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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,645	12/20/2000	Masahiro Komura	1341.1076 (JDH)	4243
21171	7590	09/22/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			COLIN, CARL G	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/739,645	<b>Applicant(s)</b> KOMURA ET AL.	
	<b>Examiner</b> Carl Colin	<b>Art Unit</b> 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. In response to communications filed on 6/30/2005 for a request to continue examination, applicant amends claims 1 and 8-15; the following claims 1-17 are presented for examination.

1. 1 In response to communications filed on 6/1/2005, applicant defines the status of the claims on top of page 2; however, claim 15 is mistakenly identified as (previously presented) while it contains some added or deleted texts, Examiner will interpret claim 15 as (currently amended) as defined by applicant on top of page 2.

1.2 Applicant's arguments, pages 7-9, filed on 6/1/2005, with respect to the rejection of claims 1-15 have been fully considered, but they are moot in view of a new ground of rejection. Applicant has amended the independent claims to recite that the security information comprising information regarding a design error or bug in a computer program. Claims 16 and 17 are added to further recite rewarding the user for submitting information regarding a design error or bug in a computer program. Torii discloses the added limitation. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

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See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). And as indicated in the last office action, to shift location of parts requires routine skill in the art-*In re Japikse* 86 USPQ 70 (CCPA 1950). Applicant has not overcome the rejection by amending the claims as the amended limitation is disclosed in the new reference Torii. The limitations of the dependent claims not challenged by applicant from the last office action still apply in this office action. Claims 1-17 are now rejected in view of Linehan and Torii.

### *Claim Objections*

2. Claim 10 is objected to because of the following informalities: claim 10 recites receiving “at the first registering step” there is lack of antecedent basis of first registering step. In order to avoid rendering the claim indefinite, the term “the first registering step” should be corrected. See MPEP § 2106.II(c). Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.1 Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,327,578 to **Linehan** in view of US Patent 5,761,308 to **Torii et al.**

3.2 As per claims 1, 8, and 15-17, **Linehan** substantially teaches a security information connected between a first terminal at an information contributor and a second terminal at an information recipient, the security information mediation apparatus comprising: **Linehan** discloses registering information between a merchant and a bank that that meets the recitation of a first receiving unit which receives security information from the first terminal a first registering unit which registers the security information in a first database (column 4, lines 9-22); and discloses the bank transferring security information to a gateway service then to the consumer that meets the recitation of first transfer unit which receives the security information from the first registering unit and transfers the security information registered by the first registering unit to the second terminal for the information recipient to judge the usefulness of the security information (see column 4, lines 18-45); the issuer gateway receives information for validation that meets the recitation of a second receiving unit which receives at least reply information including the usefulness of the security information corresponding to the security information from the second terminal (column 4, lines 24-44); authorized information is sent to the merchant that meets the recitation of a second registering unit which registers at least the reply information in a second database and a second transfer unit which receives at least the reply information from the second registering unit and transfers the reply information to the first terminal (column 4, lines 34-57) **Linehan** discloses the merchant receiving and verifying

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payment information including in an authorization token that meets the recitation of receiving and registering reply information with payment information wherein when the information recipient finds that the security information has usefulness the second receiving unit receives payment information on an information presentation fee to be paid to the information contributor from the second terminal the second registering unit registers the payment information together with the reply information and the second transfer unit transfers the payment information together with the reply information to the first terminal (column 6, lines 20-32). **Linehan** discloses the invention by way of example. It is obvious to one skilled in the art that any modification or variation such as the order of transmission of data and combining or separating the task into one or many apparatus would be a routine skill in the art and not a patentable invention but rather a design choice. One skilled in the art would have been motivated to combine the functions into one unit to save in resources or/and distribute some functions into many units to separately control the transaction so that if one unit is compromised the entire system is not. To shift location of parts requires routine skill in the art-*In re Japikse* 86 USPQ 70 (CCPA 1950). Using first, second units and databases is a minor modification of the invention disclosed by **Linehan** and one skilled in the art would have been motivated to modify the invention disclosed to fit their design need. **Linehan** suggests different embodiments involving three, four or more parties. **Linehan** discloses a way of conducting secured transaction for doing business in electronic commerce. **Linehan** does not explicitly disclose that the secured transaction is relating to a design error or bug in a computer program. It is apparent that the invention of **Linehan** can be applied to any Internet computer service that includes financial transaction. **Torii et al** in an analogous art discloses a user storing an installation history file

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(security information) comprising design error or bug or security flaw in a software, and sends the installation history file to a center (column 10, lines 24-65); the center comprising a registering unit (46), (see figures 6-7) which registers the security information in a database and other units (50) and (51) judge the usefulness of the security information and when it finds that the security information has usefulness, payment information is transferred to the first terminal user (see column 9, line 35 through column 10, line 10 and column 10, line 65 through column 11, line 65), column 11, lines 49-55 specifically discloses money is transferred to the user that meets the recitation of rewarding the user for sending the information. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the electronic commerce system of **Linehan** to integrate the concept of determining that information received from a verified user regarding a design error or bug or security flaw in a computer program is valuable, and rewarding the user for submitting the information as taught by **Torii et al**. One skilled in the art would have been lead to make such a modification because it provides a secure transaction by making sure that the user has proper right of receiving the money, and also a fair transaction by allowing both parties such as the consumer and the software provider to benefit from the transaction. For instance, in a software transaction distribution system, the provider benefits from the report of design errors in the software from the consumer because the provider or merchant can take measures so that the software can be repaired and the software can be subsequently made free or error for distribution and at the same time, the user can receive refund in form of money for reporting the defect in the software as suggested by **Torii et al** or free updated version for reporting the defect in the software (see column 1, line 51 trough column 2, line 22).

**As per claims 2 and 9, Linehan** suggests using pre-authorization to prevent delay.

Therefore it would have been obvious to one skilled in the art at the time the invention was made to register and transfer the first security information only if security information is new so as to reduce overhead (column 9, lines 2-16).

**As per claims 3 and 10, Linehan** discloses a registration authority and certificate authority to register issue and authorize requestor's identity and services and certificates that a requestor is authorized to use that meets the recitation of using a classification unit for classifying and registering (column 2, lines 52-61).

**Linehan** discloses transferring security information after authentication that meets the recitation of transfers the security information to the second terminal only if the classification information and classification result of said classification unit coincide, for example (see column 7, lines 20-67).

**As per claims 4 and 11, Linehan** discloses receiving validation information and confirmation message that meets the recitation of wherein said receiving unit receives invalidity information showing invalidity of the security information from said information recipient's terminal, and said second transfer unit transfers the invalidity information to the first terminal, for example (see column 13, lines 30-61 and column 15, lines 59-67).



**As per claims 5, 7, 12, and 14, Linehan** substantially teaches ways of showing proof if there is a dispute (column 4, lines 45) and discloses that the gateway should implement replay direction to handle error retries (column 10, lines 40-41) that meets the recitation of sending receiving correction information as a measure of validation.

**As per claims 6 and 13, Linehan** discloses the bank passing information to the issuer gateway as discussed above that meets the recitation of further comprising a disclosing unit which discloses the security information registered by said registering unit and the correction information, for example (column 10, lines 40-42; column 4, lines 9-22).

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses purchase of software in a distribution system that includes rewarding a consumer for reporting design error or bug.

US Patents: 6,327,617 Fawcett; 5,835,911 Nakagawa et al; 5,889,942 Orenshteyn.

4.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Carl Colin

Patent Examiner

September 15, 2005

  
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